

Remarks

Claims 1 and 2 are amended and claims 3-4 and 9-10 are cancelled; as a result, claims 1-2, 5-8, 11-14, 16-19 are now pending in this application. No new matter was added by way of the amendments.

Applicant would like to thank Examiner Frederick Krass for the courtesy extended during the telephonic interview on June 22, 2006 with Applicant's representative Monique Perdok Shonka. The Office Action mailed March 22, 2006 was discussed during the interview.

The 35 U.S.C. § 101 Rejection

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 101. The cancellation of claims 9 and 10 render the Examiner's rejection of those claims under § 101 moot.

It is respectfully submitted that the pending claims are in conformance with 35 U.S.C. § 101. Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 101 rejection of the claims.

The 35 U.S.C. § 112(1) Rejection

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 112, first paragraph, as lacking adequate description or enablement. The cancellation of claims 9 and 10 render the Examiner's rejection of those claims under § 112(1) moot.

Thus, with respect to the amended claims, it is respectfully submitted that the claims are in conformance with 35 U.S.C. § 112(1). Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 112(1) rejection of the claims.

The 35 U.S.C. 103(a) Rejection

The Examiner rejected claims 1-8, 11-14, and 16-19 rejected under 35 U.S.C. § 103(a) as being unpatentable over Rephaeli (U.S. Patent No. 5,939,455) in view of WO 98/09603. The amendments to claims 1 and 2 render the Examiner's rejection of the claims under 103(a) moot. Therefore, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C. § 103(a) rejection of the claims.

The Obviousness-Type Double Patenting Rejections

The Examiner provisionally rejected claims 1-20 under the judicially created doctrine of double patenting as being unpatentable over claims 1-8, 10 and 12-23 of copending Application No. 10/682,790 in view of Spiegelman et al. (U.S. Patent No. 6,552,055.) This rejection is respectfully traversed.

It is noted that this is a provisional obviousness-type double patenting rejection because the claims of the '790 application have not been allowed. Additionally, Applicant submits that there is no motivation to combine the claims of U.S. Application Serial No. 10/682,790 with the Spiegelman patent. Accordingly, reconsideration and removal of the instant rejection is respectfully requested.

Furthermore, pursuant to M.P.E.P. § 804, "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application as long there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in at least one of the applications." It is believed that the arguments and amendments presented herein obviate the remaining rejections. Thus, since the provisional obviousness-type double patenting rejection is the only rejection remaining in the instant application, the Examiner is respectfully requested to withdraw the provisional obviousness-type double patenting rejection of the instant claims.

The Examiner provisionally rejected claims 1-14 and 16-19 under the judicially created doctrine of double patenting as being unpatentable over claims 1, 3, 4, 11-14, 26-29, 34 and 35 of copending Application No. 09/589,476 taken in view of Berkow et al., The Merck Manual of Medical Information, pp 765-766 and 779-780.

To moot this rejection, while not conceding the obviousness of any number of the pending claims over the claims of the '476 application taken alone or in combination with Berkow et al., Applicant encloses herewith a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(b)(iv), to overcome this rejection. The Examiner is requested to note that Applicant is disclaiming the terminal part of the statutory term of any patent granted on the above-identified

patent application (Serial No. 10/753,665), which would extend beyond the expiration date of the full statutory term of the patent to issue from Application Serial No. 09/589,476.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6905 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

DENNIS A. CARSON ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6905

Date

July 24, 2006

By

Monique M. Perdok Shonka
Monique M. Perdok Shonka
Reg. No. 42,989

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 24th day of July, 2006.

JONATHAN FERENSON

Name

Jonathan Ferguson

Signature